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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/702,625	08/23/9	KLUTH	H H1215/1556PC
EXAMINER			

IM11/0820

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COONEY, J	
ART UNIT	PAPER NUMBER

1711

16

DATE MAILED: 08/20/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 3-30-98

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 15-68 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 15-68 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Application/Control Number: 08/702,625

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Applicants' arguments on appeal received March 30, 1998 have been considered, but are moot in view of the new grounds of rejection being set forth herein. All previous rejections are withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15-68 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 15-68 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 13 filed 3-30-98. In that paper, applicant has stated that their claims require the use of isocyanate prepolymers prepared from an isocyanate compound and an -OH group containing compound, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not require that the "prepolymer" component be anything more than an isocyanate, a polyisocyanate, a cyclotrimer of a diisocyanate (claim 23), and polymer-MDI (claim 28 and 33 {for example}). The language of the claims is confusing in its definition of the isocyanate component of the invention, and such needs to be corrected to set forth clearly what is being claimed.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-39 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Muller et al.(5,270,348) and Volkert et al.(5,278,195), and Trinks et al. (5,349,040), each taken individually.

Muller et al. and Volkert et al., and Trinks et al., each taken individually, disclose foamed plastics prepared from an isocyanate component having NCO contents inclusive of applicants' claimed ranges of values, and a polyol component (see the documents in their entirety). It is the final product that applicants are claiming and the claims are not seen to distinguish. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind - *In re Brown*, 59 CCPA 1063, 173 USPQ 685

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(1972); *In re Fessman*, 180 USPQ 324 (CCPA 1974) - and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. *In re Marosi* 218 USPQ 290.

Claims 40,52, and 59-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Muller et al.(5,270,348) and Volkert et al.(5,278,195), and Trinks et al. (5,349,040), each taken individually.

Muller et al. and Volkert et al., and Trinks et al., each taken individually, disclose foamed plastics prepared from an isocyanate component having NCO contents inclusive of applicants' claimed ranges of values, a polyol component, and other conventional foam forming additives/reactants (see the documents in their entirety).

Claims 15-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plaschka et al.(4,508,244) in view of Muller et al.(5,270,348), Volkert et al. (5,278,195), CA-2,084,698 (previously cited by applicants, and Minato et al.(5,086,175)(previously cited by applicants).

Plaschka et al. disclose a pressure can for dispensing polyurethane foam wherein a foam precursor material is stored under pressure with a propellant gas which behaves as both propellant and blowing agent (see the entire document).

Plaschka et al. differs from applicants' claims in that it does not specify what types of prepolymeric precursors are dispensed from its contents. However, it is held that the prepolymeric materials defined by applicants' claims are well known foam forming prepolymeric

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precursor materials known for their foam forming qualities as is demonstrated, for example, by the teachings of Muller et al. (see the entire document) which disclose the use of various isocyanate based prepolymers having isocyanate contents within the ranges of values defined by applicants' claims for the purpose of providing adequately formed foams. Accordingly, it would have been obvious for one having ordinary skill in the art to have utilized isocyanate based polymers as disclosed by Muller et al. in the dispensing systems set forth by Plaschka et al. for the purpose of achieving good foam qualities in order to arrive at the systems, processes, and products of applicants' claims in the absence of a showing of new or unexpected results.

Plaschka et al. differs from applicants' claims in that it does not particularly specify the use of additives such as stabilizers and catalysts in its disclosed systems. However, Volkert et al. (see the entire document) sets forth that the use of stabilizers, catalysts, and other additives and adjuvants have long been used in the art for their additive effect. Accordingly, it would have been obvious for one having ordinary skill in the art to have utilized the additives disclosed by Volkert et al. in the systems of Plaschka et al. in order to arrive at the systems, processes, and products of applicants' claims in the absence of a showing of new or unexpected results.

Plaschka et al. differs from applicants' claims in that it does not particularly specify the removal of residual monomeric isocyanate from its reactive components. However, CA-2,084,698 and Minato et al. (see both documents in their entireties) set forth that the means for removing excess monomer from isocyanate based reactive materials has long been known to the art for the purpose of reducing toxicity. CA 2,084,698 sets forth the more commonly recognized distillation method, and Minato et al. discloses the film evaporation methods. Accordingly, it would have been obvious for one having ordinary skill in the art to have reduced residual monomer contents of the prepolymers placed in the systems of the Plaschka et al. by the methods

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set forth by CA-2,084,698 and/or Minato et al. for the purpose of reducing toxicity in order to arrive at the systems, processes, and products of applicants' claims in the absence of a showing of new or unexpected results.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huygens, Bhattacharjee et al., Milliren et al., and Savoca et al. are cited for their disclosures of conventional urethane materials and foams.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is (703)308-2433. The examiner can normally be reached on Monday - Friday from 9AM-6PM.

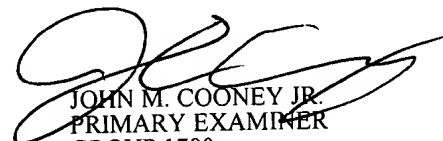
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The Official fax phone number for this Group is (703) 305-3599, and the fax phone number which examiner can access for papers is (703)306-3429.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [james.seidleck@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JMC
8-12-98



JOHN M. COONEY JR.
PRIMARY EXAMINER
GROUP 1700